

Amendment and Response

Applicant: Barbara J. Aalbers

Serial No.: 09/932,292

Filed: August 17, 2001

Docket No.: 56961US002

Title: A CONTAMINANT REMOVAL TAPE ASSEMBLY, A ROLL OF CONTAMINANT TAPE, AND METHODS OF REMOVING CONTAMINANTS FROM A SURFACE

REMARKS

This Amendment is responsive to the Office Action mailed November 8, 2002. In that Office Action, claims 23-53 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. Claims 1-22 were rejected under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §103(a) as being unpatentable over either Gobran, U.S. Patent No. 4,237,889 ("Gobran"), or Mazurek et al., U.S. Patent No. 5,650,215 ("Mazurek"), either taken individually or in view of either Christensen, U.S. Patent No. 3,115,417 ("Christensen"), or Cox et al, U.S. Patent No. 5,878,457 ("Cox"). With this Response, claims 23-53 have been cancelled and claims 1 and 12 have been amended and the restriction has been refuted. Claims 1-22 remain pending in the application and are presented for reconsideration and allowance.

Restriction Requirement under 35 U.S.C. § 121

In the Office Action, claims 1-53 were made subject to a restriction requirement under 35 U.S.C. § 121. In particular, claims 1-22 (Invention I) were said to be drawn to rolls of contaminant removal tape, and claims 23-53 (Invention II) were said to be drawn to a contaminant removal tape assembly and accompanying methods of removing contaminants. Inventions I and II were said to be related as mutually exclusive species in an intermediate-final product relationship. During a telephone conversation with Melissa Buss in November 4, 2002, a provisional election was made with traverse to prosecute claims 1-22 (Invention I). With this response, Application hereby affirms this election of invention I (i.e. claims 1-22). In addition, with this response, Applicant has cancelled claims 23-53 since they are drawn to the non-elected invention (i.e. Invention II). However, Applicant reserves the right to pursue these cancelled claims and variants thereof in a continuation/divisional patent application to be filed later.

Claim Rejections under 35 U.S.C. § 112

Claims 1-22 were rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, claims 1 and 12 were rejected due to the lack of

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relationship of the phrase "said roll includes a plurality of wraps of said tape" to "backing." Claims 1 and 12 have been amended to recite "said roll includes a plurality of wraps of said backing and said layer of adhesive," and as such, are no longer indefinite. Claims 23, 37, and 52 contained similar language and have been similarly amended.

Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, over the phrase "discontinuous contact profile" as not being distinguishable over the characterization of how the layer of adhesive is arranged in claim 1, which recites "discontinuous contact with a surface to which said roll is applied." The recitation of claim 1 relates to how the layer of adhesive is configured to interact with a surface to which it may later be applied. Claim 12, however, relates to the arrangement of the layer of adhesive on the first side of the backing without reference to how it will eventually interact with a surface. As such, claim 1 and claim 12 are believed to recite distinguishable attributes of the layer of adhesive included in each claim. As such, it is respectfully requested that the rejection under 35 U.S.C. § 112, second paragraph, to claims 1 and 12 and the claims depending therefrom be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Independent claims 1 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over either Gobran or Mazurek, either taken individually or in view of either Christensen or Cox. Amended claims 1 and 12 relate to a roll of contaminant tape including a backing having a first side and a second side opposite the first side and a layer of adhesive on the first side of the backing. Amended claim 1 further recites the layer of adhesive being arranged so as to have discontinuous contact with a surface to which said roll is applied, and amended claim 12 further recites the layer of adhesive including a discontinuous contact profile. None of the cited references teach the limitations of either amended claim 1 or amended claim 12.

Gobran fails to teach or otherwise suggest the limitations of amended independent claims 1 or 12. Gobran relates to a diaper closure utilizing pressure-sensitive adhesive tape having a textured foil backing. However, the tape disclosed in Gobran preferably has the adhesive placed over the smooth surface of the tape so that "the adhesive will be more nearly planar" and because

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the textured surface is more aesthetically appealing. (Column 2, line 68 – Column 3, line 5). Further, Gobran cites the only incentive for placing adhesive on the textured side of the tape is so “the exposed surface of the adhesive will then contact the smooth back side of the foil when the tape wound. . . thereby maintaining a nearly planar surface,” (Column 4, lines 24-31). Gobran goes on to state that formation of a planar surface is desired to establish a firm and quick bond to the diaper. (Column 4, lines 31-33). As such, even if the adhesive is applied to the textured side of the tape, the adhesive of Gobran is still applied to present a planar adhesive surface to interact with the diaper. The desire to form a firm bond by virtue of a planar adhesive surface is in direct contrast to the limitations of amended claims 1 and 12. A planar adhesive surface would interact continuously with the surface to which it is applied and, as such, would not “have a discontinuous contact with a surface to which said roll is applied,” as recited in amended claim 1. Similarly a planar adhesive surface provides a smooth and, therefore, continuous contact surface or profile rather than “a discontinuous contact profile,” as recited in amended claim 12.

In addition, Gobran actually teaches away from the limitations of amended claims 1 and 12. Gobran states that “it is important that the adhesive be capable of bonding firmly to the diaper cover.” (Column 3, lines 64-65). In fact, the bond described in Gobran is sufficiently firm that when the diaper is to be removed from the wearer, the tape is to be torn across its width rather than removed from the diaper. (Column 2, lines 31-33). As such, it would be undesirable to modify the adhesive of Gobran to form a discontinuous contact profile or to discontinuously contact the surface to which it is applied because the lack of continuous contact would diminish the integrity of the bond between the tape and the diaper, which could lead to premature release of the tape from the diaper, especially when the tape is subjected to the irregular movements of a baby or toddler. For at least the reasons described above, Gobran fails to teach or otherwise suggest the limitations of amended claim 1 or of amended claim 15.

Mazurek similarly fails to teach or otherwise suggest the limitations of amended claims 1 and 12. Mazurek relates to general pressure-sensitive adhesives having microstructured surfaces. The adhesives of Mazurek assume a microstructured surface from a molding tool, a backing, or a liner, and the adhesives maintain the microstructured surface upon separation from the molding

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tool, the backing, or the liner. (Column 7, lines 34-39). The pressure sensitive adhesives of Mazurek are used to improve general tape-like items, such as "masking tapes, removable labels or office notes, protective films, and medical tapes" which "all must quickly adhere to metal, plastics, and skin." (Column 1, lines 9-13). These general tapes must be wound such that the adhesive is protected prior to use to remain tacky and ready to adhere to various surfaces. Therefore, these tapes are generally wound adhesive towards the center or core so the adhesive level is not compromised by premature exposure to outside elements such as dirt, lint, etc. Exposure to such elements may cause the elements to stick to the exposed adhesives thereby compromising the adhesive for subsequent use. Accordingly, Mazurek actually teaches away from rolling the tape in the manner described in claim 1, as the outwardly facing adhesive would compromise the effectiveness of the adhesive and may, thereby, render the adhesive unable to serve its intended purpose. Accordingly, Mazurek fails to suggest the modification of amended claims 1 and 12 as required for a finding of obviousness. *See MPEP 2143.01.*

Christensen and Cox fail to alter the above analysis as neither of the references includes backing having a textured surface. In light of the teachings of Mazurek, a requisite suggestion to modify Mazurek in view of Christensen or Cox does not exist. Therefore, in view of at least the above described reasons, none of the cited references teach or otherwise suggest the limitations of amended claim 1 or amended claim 12. Consequently, amended claims 1 and 12 are believed to be allowable.

Claims 2-11 and 13-22 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over either Gobran or Mazurek, either taken individually or in view of either Christensen or Cox. Claims 2-11 and 13-22 depend from either independent amended claim 1 or independent amended claim 12. As described above, amended claims 1 and 12 are believed to be allowable. Consequently, dependent claims 2-11 and 13-22 are also believed to be allowable.

In addition, claims 2 and 13 recite additional patentably distinct limitations. As illustrated in Figures 1, 2, and 5a-5c, the backing of the end tape product is smooth on both sides and, as such does not include a "first side that is a textured surface," as recited in amended claims 2 and 13. In the Mazurek embodiments illustrated in Figures 3a-3c and 4a-4c, the

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backing includes a smooth side and a microstructured side. However, each of these embodiments fails to meet the limitations of claim 2 or claim 13. In the embodiment illustrated in Figures 3a, 3b, and 4a, the adhesive forms a planar surface and, as such, is not arranged to have discontinuous contact to a surface to which it is applied. In the embodiment illustrated in Figures 3c and 4c, the adhesive is not on the side of the backing having a textured surface. Consequently, none of the embodiments of Mazurek teach or otherwise suggest the limitations of amended claims 2 and 13.

CONCLUSION

In light of the above, Applicant believes independent claims 1 and 12, and the claims depending therefrom, are in condition for allowance. Notice to that effect is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 500471.

Attached hereto is a marked-up version of the changes made to the specification and/or the claims by the current Amendment. The attached pages are captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**".

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The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this response.

Respectfully submitted,

Barbara J. Aalbers,

By her attorneys,

DICKE, BILLIG & CZAJA, P.A.

701 Building, Suite 1250

701 Fourth Avenue South

Minneapolis, MN 55415

Telephone: (612) 573-2004

Facsimile: (612) 573-2005

Date: FEBRUARY 10, 2003

TAC: jms: kmd

Timothy A. Czaja

Reg. No. 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, Washington, D.C., 20231 on this 10th day of February, 2003.

By Timothy A. Czaja

Name: Timothy A. Czaja